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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/532,758

04/27/2005

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EXAMINER

BALDWIN, GORDON

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

12/02/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/532,758	<b>Applicant(s)</b> ICHIKAWA ET AL.	
	<b>Examiner</b> GORDON R. BALDWIN	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-38 is/are pending in the application.
- 4a) Of the above claim(s) 27-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20050427, 20050805, 20050920, 20070919</u> .                  | 6) <input type="checkbox"/> Other: _____                          |



## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of claims 19-26 in the reply filed on 10/27/2008 is acknowledged. The traversal is on the ground(s) that there is not a serious burden. This is not found persuasive because the traversal is on the grounds that there is no undue burden in examining both the group I and group II claims. Applicants further argue that the groups of claims are not so unrelated as would require a burden beyond that of the normal burdens of examination. This argument has been considered, but not found persuasive. MPEP § 808.02 recites that for the purposes of the initial requirement of a restriction, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. Since the Examiner has shown a different classification for the two groups of claims, a burden for examining both groups has been shown.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 19 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 63-144836 ('836).**

**Consider claims 19 and 22,** '836 discloses a ceramic honeycomb structure with partition walls forming a plurality of cells partition into a honeycomb shape. (Abstract and Figure 5) '836 also discloses that the outer surface of this partitioned honeycomb structure has recesses with an outer wall disposed on and in the outer peripheral surfaces containing recesses. (Abstract and figure6b) The outer wall (5) appears to form a void (7) between the outer wall and the honeycomb structural part (9) in figures (1b) (3a) (4a). In figure 4a, there seems to be a definite interface at 6a between the outer wall and the honeycomb structural part.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 63-144836 ('836).**

**Consider claim 20**, “836 does not explicitly disclose a contact ratio between the outer wall and the honeycomb part, however, in the variety of figures (1b) (3a) (4a) of ‘836, it seems as though the amount the outer wall actually touches the honeycomb part is controllable with the amount of outer wall ceramic material is added to the recessed surface of the honeycomb part. Therefore, the average contact ratio is considered to be optimizable depending on how much of an interface is desired between the outer wall and the honeycomb part. It would have been obvious to one having ordinary skill in the art at the time of the invention to adjust the contact ratio for the intended application, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

**Claims 21, and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 63-144836 (‘836) as applied to claim 19 above, and further in view of Mitzutani (U.S.Pat. No. 4,840,827).**

**Consider claim 21**, '836 discloses the honeycomb structure of claim 19 but does not disclose that the honeycomb part and the outer peripheral wall are made of a ceramic material; Mitzutani disclosed that it is known to make both the honeycomb part and the outer peripheral wall out of cordierite (a ceramic material). (Col. 3 lines 1-8)

It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the honeycomb structure of ‘836 with the honeycomb structure utilizing ceramic parts and outer walls of Mitzutani to increase the performance for sealing gas. (Col. 3 lines 1-8)

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**Consider claims 23-26**, Mitzutani discloses that it is known to have a honeycomb with an absorption and catalyst function (Col. 5 lines 1-15) in addition to some of the cells being plugged and used as filters. (Col. 3 lines 6-18). Mitzutani also discloses that the ceramic honeycomb structure is to be used as a Diesel Particulate Filter (DPF) utilizing catalyst to filter engine combustion. (Col. 2 lines 47-65)

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GORDON R. BALDWIN whose telephone number is (571)272-5166. The examiner can normally be reached on M-F 7:45-5:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GRB

/Timothy M. Speer/  
Primary Examiner  
Art Unit 1794